

REMARKS

Claims 1-21, all the claims pending in the application, stand rejected on prior art grounds. Applicants respectfully traverse these objections/rejections based on the following discussion.

I. The Prior Art Rejections

Claims 1-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Sziklai, et al. (U.S. Patent No. 6,341,287), hereinafter referred to as Sziklai. Applicants respectfully traverse these rejections based on the following discussion.

Sziklai teaches an integrated system for managing changes in regulatory and non-regulatory requirements for business activities at an industrial or commercial facility. Examples of applications of this system include environmental, health and safety activities, and food, drug, cosmetic, and medical treatment and device activities. The system provides one or more databases that contain information on operations and requirements concerning an activity or area of business; receives information on regulatory and non-regulatory changes that affect operations of the business; converts these changes into changes in data entry forms, data processing and analysis procedures, and presentation (by printing, electronic display and/or distribution) of data processing and analysis results to selected recipients, without requiring the services of one or more programmers to re-key and/or reformat the items affected by the change; and implements receipt of change information and dissemination of data processing and analysis results using the facilities of the Internet.

However, the claimed invention, as provided in amended independent claims 1, 8, and 15 contain features, which are patentably distinguishable from the prior art references of record, and

10/015,256

7

in particular Sziklai. Specifically, claims 1 and 15 provide, "...determining whether breaches in security of said data processing system has occurred in each phase of development of a computer application program." Similarly, claim 8 provides, "...wherein said third database tool is adapted to determine whether breaches in security of said data processing system has occurred in each phase of development of a computer application program." These features are simply not taught or suggested in Sziklai.

Page 9 of the Office Action admits that Sziklai "does not go into full detail of 'determining security breaches'". Nonetheless, the Office Action concludes that Sziklai sufficiently teaches or anticipates "determining whether breaches in security of said data processing system has occurred in each phase of development of a computer application program" as provided in the claimed invention. It appears that the Examiner has chosen to conduct a keyword search in the Sziklai reference looking for any mention of the word "security" and has used this to conclude that Sziklai teaches the above feature of the claimed invention irrespective of what context Sziklai is using the word "security" in, and how broadly the term is being used in Sziklai. As such, Applicants strongly suggest that with respect to the determination of security breaches, Sziklai is and should properly be considered a non-enabling reference, and thus should not be considered as prior art for the purposes of teaching "determining whether breaches in security of said data processing system has occurred in each phase of development of a computer application program."

In fact, case law suggests that non-enabling inventions should not be considered prior art. See, e.g., In re Wilder, 429 F.2d 447, 166 USPQ 545, 548 (C.C.P.A. 1970) (anticipation rejection):

10/015,256

8

However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within the possession of the public. See, e.g., In re LeGrice, 301 F.2d 929, 133 USPQ 365 (C.C.P.A. 1962); In re Brown, 329 F.2d 1006, 141 USPQ 245 (C.C.P.A. 1964).

The Federal Circuit went on to provide, "the prior art must enable one skilled in the art to make and use the apparatus or method." Rockwell Int'l Corp. v. United States, 147 F.3d 1358, 47 USPQ 2d 1027, 1032 (Fed. Cir. 1998) (citing Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1471, 43 USPQ 2d 1481, 1489 (Fed. Cir. 1997)).

Here, as admitted in the Office Action (see page 9), Sziklai does not "does not go into full detail of 'determining security breaches'". Thus, Sziklai does not properly enable one skilled in the art to make and use the invention in Sziklai for the purposes of the manner and approach of determining whether security breaches occur. Furthermore, with respect to determining whether security breaches occur, clearly Sziklai does not place the claimed invention within the possession of the public as required by well-established and legally binding case law.

Additionally, even if by some inexplicable chance that one of ordinary skill in the art would refer to Sziklai and conclude that it sufficiently teaches determining whether security breaches occur, it would be a gross stretch of reason that one of ordinary skill in the art would conclude that Sziklai sufficiently teaches determining whether breaches in security of a data processing system has occurred in each phase of development of a computer application program. There is simply no teaching of this aspect or reasonable interpretation of the broad non-enabling concepts described in Sziklai of this second aspect of the claimed feature.

Again, the features relating to security are novel features not taught in Sziklai.

10/015,256

9

Specifically, column 9, lines 13-16 of Sziklai only generically refers to the fact that security is an important feature in database management. There is no mention of how such an implementation of security is to take place, let alone a determination of when breaches in security occur in the development of a software program (i.e., computer application program). That is, there is nothing in this language that suggests that determining whether breaches in security of a data processing system has occurred in each phase of development of a computer application program.

Next, column 14, lines 50-58 of Sziklai refer to "[t]he Java security model prevents unauthorized tampering with the client machine using non-authenticated code." However, this merely suggests that Sziklai's system uses a Java framework for preventing unauthorized tampering using non-authenticated code. However, this does not suggest, and no logical interpretation of this would suggest that the Java framework implemented by Sziklai can determine whether security breaches have occurred in all phases of the development of a software program. Furthermore, column 21, lines 65-67 of Sziklai once again very generically, and in non-enabling language, establishes implementing a security role to grant/restrict access to the database. However, there is no teaching of how this is accomplished in the context of software development, let alone in what phase of development of the software program this occurs.

As previously mentioned, this is particularly clear because Sziklai focuses on the application of its system to environmental, health and safety activities, and food, drug, cosmetic, and medical treatment and device activities, and not computer program (software) development as does the claimed invention. In other words, Sziklai's system is not implementable in a

software development scheme provided by the claimed invention. Thus, Sziklai's system is incapable of monitoring all phases of software development and determine whether security breaches have occurred, thereby clearly establishing the claimed invention novel and patentable over Sziklai.

In view of the foregoing, the Applicants respectfully submit that the cited prior art reference, Sziklai, does not teach or suggest the features defined by independent claims 1, 8, and 15 and as such, claims 1, 8, and 15 are patentable over Sziklai. Further, dependent claims 2-7, 9-14, and 16-21 are similarly patentable over Sziklai, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

II. Formal Matters and Conclusion

In view of the foregoing, Applicants submit that claims 1-21, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The changes made to the claims in this amendment are made to clear grammatical errors in the claimed invention, and is not made to narrow the scope of the claimed invention. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to


10/015,256

11

discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

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10/015,256

12